

## **REMARKS/ARGUMENTS**

Claims 71-79 and 93-112 remain in the application for further prosecution. Claims 55-70 and 80-92 have been cancelled. Claims 93-112 have been added. The Applicants' confirm that the inventorship for the remaining claims has not changed.

### **Personal Interview**

The Applicants note with appreciation the personal interview of December 11, 2007, between Applicants' representatives, Jeremie Moll and Sorinel Cimpoes, and Examiner Robert Pezzuto.

During the interview, the Applicants' representatives gave a demonstration of a game button, which is one implementation of the game button claimed in claims 71 and 93. In addition to the demonstration, arguments were presented regarding a negative limitation rejection under 35 U.S.C. § 112, first paragraph, and an obviousness rejection under 35 U.S.C. § 103.

The Applicants' representatives agreed to add claims that included with more specificity the location of various features. Examiner Pezzuto agreed that such claims appear to distinguish over the art of record, although a new search would be conducted. As such, claims 93-112 have been added.

The Applicants' representatives also proposed including an inventor declaration under 37 C.F.R. § 1.132 as support against the rejections. Examiner Pezzuto agreed that the declaration would be beneficial to overcoming the rejections.

Lastly, the Applicants' representatives indicated that they would take under consideration whether they would make any amendments to claims 71-79. As explained in more detail below, the Applicants believe that claims 71-79 are in compliance with the requirements of the first paragraph of 35 U.S.C. § 112 and are not obvious under 35 U.S.C. § 103 in view of the cited art.

### **Specification**

#### *Abstract*

The Abstract has been objected to because it allegedly does not describe the currently claimed invention. The Abstract of the current application has been replaced by a new Abstract, in accordance with the Examiner's suggestions.

### *Title*

The Title of the current application has been objected for allegedly being not descriptive. The Title of the current application has been replaced with the title suggested by the Examiner.

### **Drawings**

The drawings have been objected under 37 C.F.R. § 1.83(a) because they allegedly do not show every feature of the invention specified in the claims. Specifically, the office action alleges that “the subject matter claimed in the negative limitations discussed below must be shown.”

Claim 71 is directed to a memory that is associated solely with a game button and not another game button. FIG. 15 of the current application shows an exploded view of a game button 76 in accordance with one embodiment. The exploded view shows a microcontroller 83, having a microprocessor and a memory, that is included in the game button 76. Additional details regarding the game button 76 are included, for example, in the specification in ¶¶ 0048-0061. One of ordinary skill in the art would clearly understand at least from FIG. 15 and/or the associated description that the memory of microcontroller 83 is not associated with another game button. The attached Declaration of Charles R. Bleich Under 37 C.F.R. § 1.132 (“Bleich Declaration”) provides additional support that the negative limitations are shown in the current drawings. Additional arguments regarding the negative limitation are provided below in reference to the § 112 rejections.

Thus, the Applicants respectfully submit that the drawings are in compliance with 37 C.F.R. § 1.83(a).

### **§ 112 Rejections**

Claims 71-79 have been rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the written description requirement. Specifically, claim 71 has been rejected because it contains the negative limitation “the member being associated solely with the game button and not another game button,” which allegedly is not supported by the specification.

As discussed above in reference to the drawings, the rejected negative limitation is supported by the specification, both in the drawings and in the Description of the Preferred Examples section. Further support is provided by the Bleich Declaration, which describes in more detail that one of ordinary skill in the art would clearly understand that the disclosed game

button has a memory that is not associated with another game button. See, e.g., Bleich Declaration, ¶¶ 5-8.

Additionally, the MPEP makes it clear that “a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support.” MPEP, Rev. 6, Sept. 2007, § 2173.05(i), p. 2100-228, right column (citing to *Ex Parte Parks*, 30 U.S.P.Q. 2d 1234, 1236 (Bd. Pat. App. & Inter. 1993)). The Board of Patent Appeals and Interferences in *Ex Parte Parks* elaborated in more detail that what is important is for one of ordinary skill in the art to understand that the Applicant had possession of the claimed concept:

The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention on any ground is always upon the examiner. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In rejecting a claim under the first paragraph of 35 U.S.C. 112 for lack of adequate descriptive support, it is incumbent upon the examiner to establish that the originally-filed disclosure would not have reasonably conveyed to one having ordinary skill in the art that an appellant had possession of the now claimed subject matter. *Wang Laboratories, Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993). Adequate description under the first paragraph of 35 U.S.C. 112 does not require *literal* support for the claimed invention. *In re Herschler*, 591 F.2d 693, 200 USPQ 711 (CCPA 1979); *In re Edwards*, 568 F.2d 1349, 196 USPQ 465 (CCPA 1978); *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976). Rather, it is sufficient if the originally-filed disclosure would have conveyed to one having ordinary skill in the art that an appellant had possession of the concept of what is claimed. *In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973).

*Ex Parte Parks*, 30 U.S.P.Q. 2d at 1236 (underlining added). In our case, as evidenced at least by the Bleich Declaration, the originally-filed specification (e.g., FIG. 15 and ¶¶ 0048-0061) would have certainly conveyed to one of ordinary skill in the art that the Applicants had possession of the negative limitation “the member being associated solely with the game button and not another game button.”

Thus, at least for the above-stated reasons, the Applicants respectfully submit that claims 71-79 are in compliance with the requirements of the first paragraph of 35 U.S.C. § 112.

### **103 Rejections**

Claims 71-79 have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 6,454,649 to Mattice *et al.* (“Mattice”). Claim 71, which is

the only rejected independent claim, is directed to a “member being associated solely with the game button and not another game button.” The office action acknowledges that Mattice “is silent on whether game buttons share memory.” Nevertheless, the office action alleges that associating the memory solely with the game button is “a matter of design choice for which no stated problem is solved, or unexpected result obtained.” The office action adds that “since this feature is not describe din the specification, it cannot be said to be a critical feature.”

Examiner Pezzuto acknowledged during the personal interview that Mattice fails to teach or suggest the claimed invention, and that the demonstrated game button shows advantages over prior art game button. For example, the claimed game button having its own memory allows sale and replacement of individual buttons without having to replace an entire button panel. In another example, the claimed game button can be used in a standard button panel that does not have its own associated microprocessor. Also, there is no need for redesigning a button panel.

As agreed during the personal interview, the Applicants have attached a declaration to describe in more detail why one of ordinary skill in the art would be discouraged from including a memory in an individual game button, *e.g.*, why Mattice teaches away from the claimed game button. *See, e.g.*, Bleich Declaration, ¶¶ 11-13. In accordance with the Bleich Declaration (and in contrast with the allegation in the office action that “Mattice is silent on whether game buttons share memory”), Mattice discloses memory sharing. *See, e.g.*, Mattice, col. 9, ll. 22-25 (“switch controller 516 provides circuitry for interfacing between the gaming terminal microprocessor CPU 518 and the programmable display switch modules 512a-512h”); col. 10, ll. 21-25 (“a microprocessor 812 is coupled to wager input devices such as a coin input 814 or bill acceptor 816 and is also coupled to a plurality of (an array of) programmable display switches 818a-818f”); FIG. 5; and FIG. 8. The programmable display modules of Mattice are controlled like any standard pushbuttons. Nowhere does Mattice teach or suggest that the disclosed programmable display switches, such as programmable display switch modules 512a-512h, are controlled any differently than standard pushbuttons. Bleich Declaration, ¶ 11.

Even if, arguably, Mattice provides a motivation to associate a memory with an individual game button (which it does not), one of ordinary skill in the art would not have placed a memory within the individual buttons. For example, one reason why one of ordinary skill in the art would not have placed a memory within the individual buttons (*e.g.*, would not have included another microprocessor in addition to the Mattice gaming terminal microprocessor 518), is because it would increase manufacturing costs without providing a recognizable benefit

to one of ordinary skill in the art. Bleich Declaration, ¶ 12. Another reason why one of ordinary skill in the art would not have placed a memory within the individual buttons is because game buttons are constantly depressed and released by a player, or “pounded on” by players. Thus, one of ordinary skill in the art would have avoided placing a sensitive component (such as a microprocessor having a memory) in the gaming button. Bleich Declaration, ¶ 13.

Thus, the Applicants respectfully submit that claims 71-79 are patentable over Mattice at least for the above stated applicable reasons.

### **New Claims**

New claims 93-112 have been added in accordance with the discussion during the personal interview. These claims are generally directed to having a memory that is “enclosed within” an enclosure of the gaming button. For example, claim 93 is directed to having the memory “located in the enclosure and being physically located between the variable display and the sensor”; claim 102 is directed to having the memory “communicatively coupled with the at least one variable display and being physically located in the button enclosure between the variable display and the sensor”; and claim 109 is directed to having a microprocessor “mechanically coupled to the chassis [of the intelligent game button] and located between the variable display and the sensor,” wherein the microprocessor includes a memory. Support for these claims can be found, for example, in FIG. 15, and ¶¶ 0048-0061.

None of the claim elements listed above is disclosed by Mattice. Further, at least for the same applicable reasons discussed above in reference to claims 71-79, one of ordinary skill in the art would not be motivated, in view of Mattice, to modify a game button to include a memory.

**Conclusion**

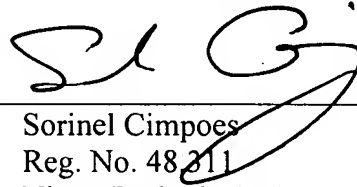
It is the Applicants' belief that all of the claims are now in condition for allowance and action towards that effect is respectfully requested. If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at the number indicated.

A check for \$1050 is included to cover a three-month extension of time fee. It is believed that no additional fees are required; however, should any additional fees be required (except for payment of the issue fee), the Commissioner is authorized to deduct the fees from Nixon Peabody LLP Deposit Account No. 50-4181, Order No. 247079-000214USP1.

Respectfully submitted,

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By



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